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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,512	10/24/2003	Tor McPartland	57974-5006	9303

7590

12/05/2006

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EXAMINER
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PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/692,512	<b>Applicant(s)</b> MCPARTLAND, TOR	
	<b>Examiner</b> Alton N. Pryor	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-6 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6, 9-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

I. Rejection of claims under 35 USC 112, 1<sup>st</sup> paragraph will not be maintained in light of amendment filed 9/18/06.

II. 35 USC 103(a) Rejections recited in office action mailed 5/18/06 will not be maintained in light of amendment filed 9/18/06. None of the references recite that PEG-castor oil enhances the consistency of the composition.

Applicant's arguments, see paper, filed 9/18/06, with respect to the rejection(s) of claim(s) under 35 USC 103(a) have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of art below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,9-11, 13-17, 22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotolo (US 4379168; 4/5/83). Dotolo teaches a composition comprising 20 % d-limonene, 4 % emulsifier (surfactant), and remainder water (76 %). See Example 14. Dotolo teaches that the d-limonene contains a preservative. See column 6 lines 40-43. Dotolo teaches that the composition can repel or kill insects. See column 7 lines 34-43. Dotolo teaches that the composition controls lice. See column 7

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lines 3-4. Dotolo teaches a method of applying the composition to house surfaces such as walls and floors and to animals as a topical application. See column 7 lines 5-11.

Doloto teaches that the composition can be made by the simple act of mixing d-limonene, emulsifier, and remainder water. See claims 34 –36. Dotolo teaches that nonionic emulsifiers (surfactants) such as TON X-100 and IGEPAL CO-630 are specifically used in his invention. See column 1 lines 52-68. Dotolo explains that these surfactants contain a number of ethylene oxide (EO) units. See column 1 line 68 – column 2 line 3. Dotolo also teaches that his invention is open to other suitable surfactants, which can be nonionic, cation, anionic and amphoteric type. See column 2 lines 4-10. Dotolo teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil surfactant and 2) amount (0.01-5%) of preservative. However, in the absence of a showing of unexpected results for the prior art surfactants versus PEG-castor oil, it would have been obvious to one having ordinary skill in the art to modify the invention taught by Dotolo to include PEG-castor oil. One would have been expected to do this since Dotolo is open to the inclusion of suitable surfactants and since PEG-castor oil contains a number of EO units which are units also contained in the TON X-100 and IGEPAL CO-630 surfactants (Note that PEG-castor oil, TON X-100 and IGEPAL CO-630 are non-ionic surfactants). One would have been motivated to do this because all three surfactants are similar in chemical and physical properties and therefore, would have been expected to exhibit a similar function when used in the same capacity. It would have been obvious to one having ordinary skill in the art to

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determine the optimum amount of preservative to include in the composition. One would have been motivated to do this in order prevent the composition from becoming rancid.

Claims 1-3,6,7,9,11-15,20,21,24 are rejected under 35 U.S.C. 102(b) as being obvious over Liebman (CA 2060594; 8/6/92). Liebman teaches a method of applying a shampoo or lotion composition comprising d-limonene, emulsifiers (cocoamido propyl betaine, sodium lauryl sulphate, ethyl methacrylate) and water and / or alcohol to human head / hair / skin to contact lice. Leibman teaches that the method is used to prevent lice infestation in human hair and on skin. See page 1 lines 5-8, page 3 lines 5-22, page 6 examples. . Liebman teaches generically that emulsifiers can be added to his invention. See page 4 lines 16-19. Liebman also teaches that modifications to the disclosed embodiments can be made without departing from the scope of his invention. See page 9 lines 26-29. Liebman teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil and 2) instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent. However, in the absence of a showing of unexpected results for the prior art surfactants versus PEG-castor oil, it would have been obvious to one having ordinary skill in the art to modify the invention taught by Liebman to include PEG-castor oil. One would have been expected to do this since Liebman generically teaches the inclusion of surfactants (emulsifiers) and since Liebman also teaches that modification to the disclosed embodiments can be made without departing from the scope of his invention. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been

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motivated to do this in order to develop a lotion that would have been effective in killing lice, but yet non-toxic to animals being treated.

Claims 1,2,6,7,9,11-15,17-19,21,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins, Jr. (US 5951991; 9/14/99). Wilkins, Jr. teaches a method of applying a composition comprising 2-10 % d-limonene, 1-10 % emulsifier, and 80-96 % water to crop or plants to control fire ant infestation. See abstract, column 2 line 1- column 3 line 35. Wilkins, Jr. teaches that a nonionic surfactant such as Mazclean is specifically used in his invention. See column 3 lines 9-10. Wilkins, Jr. also teaches that his invention is open to any suitable surfactant. See column 3 lines 7-9. Wilkins, Jr. does not teach 1) the invention comprising a polyethoxylated castor oil and 2) the invention comprising instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent, 3) the plants being rose bushes and ornamentals. However, in the absence of a showing of unexpected results for the prior art surfactant versus PEG-castor oil, it would have been obvious to one having ordinary skill in the art to modify the invention taught by Wilkins, Jr. to include PEG-castor oil. One would have been expected to do this since Wilkins, Jr. is open to the inclusion of any suitable surfactant (Note that PEG-castor oil and Mazclean are non-ionic surfactants). One would have been motivated to do this because both surfactants are similar in chemical and physical properties and therefore, would have been expected to exhibit a similar function when used in the same capacity. Wilkins, Jr. teaches 2-10% d-limonene; whereas, the instant claims uses a high of 1.5% d-limonene. In the absence of unexpected results, one having ordinary skill in the art would expect Wilkins'

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composition comprising 2% d-limonene to yield similar if not the same results as the instant composition comprising 1.5% d-limonene, which is just slightly below 2%. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a composition that would have been effective in killing insects, but yet non-toxic to humans. With respect to rose bushes and ornamentals, said plants are species within the plant genus; the instant method to said named plants. One would have been motivated to do this since rose bushes and ornamentals are species within the plant genus.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized flourish at the end.

Alton Pryor  
Primary Examiner  
AU 1616